



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,101	03/30/2001	Jason Pluta	DEX-0205	4789
26259	7590	11/05/2003	EXAMINER	
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			YU, MISOOK	
			ART UNIT	PAPER NUMBER
			1642	
DATE MAILED: 11/05/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/823,101

Applicant(s)

PLUTA ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1642

The Examiner of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Misook Yu.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26, 2003 has been entered.

Claims 1, and 3-6 are pending and examined on merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, and 3-6 **are newly rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (b) recites the limitation "the same protein" in 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 1, and 3-6 **remain rejected** for reasons different than the reason of record under 35 U.S.C. 112, first paragraph, as failing to comply with the **written description** requirement. The claim(s) contains subject matter which was not

Art Unit: 1642

described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is made due to claim 1 (b) and the limitation "a SSG polypeptide" in claims 5 and 6. The chemical structure of "a SSG polypeptide" encoded by SEQ ID NOs 1...or 13 are critical in order to describe the degenerate nucleic acid sequences claimed in instant claim 1 (b). However, the specification as filed does not describe what are the necessary protein structures, thereby failing to describe the instantly claimed nucleic acid structures. Note the entire specification, especially pages 49-58 that say the SEQ ID NOs 1-13 are EST sequences and the specification does not teach what kind(s) of proteins are encoded by the ESTs if any is encoded at all.

Claims 1, 3, and 4 **are newly rejected** under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NOs 1-13, does not reasonably provide enablement for degenerate nucleic acid molecules encoding the proteins encoded by SEQ ID NOs 1-13. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The protein sequences encoded by SEQ ID NOs 1-13 are imperative in order to make degenerate nucleic acid molecules encoding the same protein encoded by "SEQ ID NOs 1....or 13". Since the specification does not teach the necessary protein sequences, one in skilled would not know how to make the degenerate nucleic acid molecules.

Claims 5 and 6 are **newly rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are drawn to method of producing "a SSG polypeptide" or producing a cell expressing a SSG polypeptide". This rejection is made because the specification fails to teach how to make "a SSG polypeptide". The specification says that SEQ ID NOs 1-13 are EST sequences and Hatzigeorgiou et al, Bioinformatics. 2001 Oct;17(10):9 13-9 teach that finding correct translation reading frame from ESTs are not trivial matter at the current state of art because EST sequences could have various mistakes or a particular EST might be non-translated regions. Note Introduction at page 913. Considering state of art and no guidance in the specification about how to make a protein using the instantly disclosed nucleic acid, it is concluded that undue experimentation is required to practice instantly claimed invention.

Claim Rejections - 35 USC § 102

The rejection of claims under 35 U.S.C. 102(b) as being anticipated by Kato et al 1983, Nucleic Acid Research, vol., 11, pages 8197-203) is **withdrawn** because the Office could not meet the burden that nucleic acid molecule of the prior art and instantly claimed nucleic acids are same: it is not feasible to compare something unknown i.e. nucleic acid molecules encoding an unknown protein encoded by SEQ ID NOs 1...or 13 against the nucleic acid of the prior art.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu
October 27, 2003.


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600